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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,448	09/06/2006	Sabrina Higgins	102792-609 (11382P1 US)	1281
27389	7590	05/26/2010		
PARFOMAK, ANDREW N. NORRIS MCLAUGHLIN & MARCUS PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022			EXAMINER ROONEY, NORA MAUREEN	
			ART UNIT 1644	PAPER NUMBER
			MAIL DATE 05/26/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,448	Applicant(s) HIGGINS ET AL.	
	Examiner NORA M. ROONEY	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed on 02/08/2010 is acknowledged.
2. Claims 1, 4-11 and 13-19 are pending and currently under examination as they read on a method for treating an allergen-contaminated inanimate substrate comprising: dispersing an allergen-reducing amount of an allergen-deactivating compound comprising orange oil, terpene hydrocarbon, β -pinene or citrus oil dispersed into an airspace in at which an allergen-contaminated inanimate substrate is located, to provide achieve a prolonged reduction in the allergen loading of the substrate, wherein the reduction after 14 days is at least as great as the initial reduction of claim 1.
3. In view of Applicant's response filed on 02/08/2010, only the following rejections are maintained.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4-11 and 13-19 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No.10/595,767 for the same reasons as set forth in the Office Action mailed on 10/09/2009.

Applicant's arguments filed on 02/08/2010 have been fully considered, but are not found persuasive.

Applicant argues:

"The applicant traverses the Examiner's present requirement and the "double patenting" rejection as being untimely and thus inappropriate. No claims in the present application have been deemed to be allowable, and it is noted that no claims in the I0/597767 application have also been deemed allowable. Thus it is believed that the Examiner's requirement is both premature, and inequitable to insist upon the entry of a Terminal Disclaimer at the present date which would unfairly compromise the applicant's potential interest in scope of patent protection in both of the currently co-pending applications. Upon indication of allowable subject matter in either application, the application will be in a better position to comply with the mandates of MPEP § 822 and requests that the Examiner reinstate the present rejection at such later date, should the basis for such a rejection be considered appropriate."

It is the Examiner's position that the instant rejection is not untimely or inappropriate. As such, the rejection stands until the conflicting claims are amended or cancelled or a Terminal Disclaimer is filed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-8, 11 and 13-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by GB Patent Application Publication 2 367 243 (Reference 11; IDS filed on 07/26/2006) for the same reasons as set forth in the Office Action mailed on 10/09/2009.

Applicant's arguments filed on 02/08/2010 have been fully considered, but are not persuasive.

Applicant argues:

"The applicant traverses the Examiner's rejection of the claims, as the disclosure of GB243 fails to disclose the subject matter of the claims. The GB243 reference is wholly silent as to any long term effects of the use of its compositions and processes. The Examiner has failed to provide any documentation or other showing to support the Examiner's presupposition that the claimed properties would be inherent or would be both recognized and understood by a skilled artisan. The Examiner has failed to meet their burden of proof. A rejection under 35 USC 102Co) cannot be based on a presumption or conjecture. See *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d i 161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the claim, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency). See also *Trintec Indus., Inc. v. Top- US.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002); *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983)."

GB Patent Application Publication 2 367 243 teaches a method for treating a dust mite allergen-contaminated inanimate substrate comprising: dispersing an allergen-reducing amount of an allergen-deactivating compound comprising a volatile oil such as terpene hydrocarbon into an airspace as a vapour using heat by a candle, particularly a gel candle, up to 10 hours into an

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airspace in which an allergen-contaminated inanimate substrate (floor, tray) is located, to provide achieve a prolonged reduction in the allergen loading of the substrate into an airspace (In particular, abstract, page 3, lines 13-30, Examples 1 and 2, whole document). The recitation of "wherein the reduction after 14 days is at least as great as the initial reduction" of claim 1; and "wherein the reduction after 28 days is at least as great as the initial reduction" of claim 11 is inherent. The same method is being performed, so the result is inherent.

It is the Examiner's position that Applicant is arguing limitations into the claims that are not present when they argue that GB Patent Application Publication 2 367 243 is silent with respect to "long term effects" because the claimed invention is not directed to any long term effects elicited by the method. The claims are directed to allergen reduction for 14 days and 28 days.

The same method is being performed in GB Patent Application Publication 2 367 243 as that of the instant claims, so the result of allergen reduction for 14 days and 28 days is necessarily inherent. "It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it." *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). See, e.g., *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed.Cir.1999) ("Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.") There is no difference between the claimed method and the method of GB Patent Application Publication 2 367 243. Therefore, the reference teachings anticipate the claimed invention.

8. Claims 1, 4-8, 11 and 13-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/76371 (Reference 2; IDS filed on 07/26/2006) for the same reasons as set forth in the Office Action mailed on 10/09/2009.

Applicant's arguments filed on 02/08/2010 have been fully considered, but are not persuasive.

Applicant argues:

"The Applicant traverses the Examiner's rejection of the claims, as the disclosure of WO371 fails to disclose the subject matter of the claims. The disclosure of the WO371 reference is similar to that of the prior OB243 reference. The gist of the WO371 document is found at the following passages from pages 2 and 3"

"However, as in the prior GB243 reference, the WO371 reference is wholly silent as to any long term effects of the use of its compositions and processes. The Examiner has failed to provide any documentation or other showing to support the Examiner's presupposition that the claimed properties would be inherent or would be both recognized and understood by a skilled artisan. The Examiner has failed to meet their burden of proof. A rejection under 35 USC 102(b) cannot be based on a presumption or conjecture. See *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743,745 [49 USPQ2d 1949] (Fed. Cl. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency). See also *Trintee Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002); *I/EL. Gore v. Garlock Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983)."

WO 01/76371 teaches a method for treating a dust mite allergen-contaminated inanimate substrate comprising: dispersing as a vapour an allergen-reducing amount of an allergen-deactivating compound comprising a volatile oil such as terpene hydrocarbon into an airspace using heat by an oil burner or candle up to 10 hours into an airspace in which an allergen-contaminated inanimate substrate (floor, tray) is located, to provide achieve a prolonged

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reduction in the allergen loading of the substrate (In particular, abstract, page 2, lines 11-13 and 17-20, page 5, line 11 to page 6, line 17, page 8, line 1, page 10, line 18, figure 1, figure 3 Examples 1-10, claims 1-11, whole document). The recitation of "wherein the reduction after 14 days is at least as great as the initial reduction" of claim 1; and "wherein the reduction after 28 days is at least as great as the initial reduction" of claim 11 is inherent. The same method is being performed, so the result is inherent.

It is the Examiner's position that Applicant is arguing limitations into the claims that are not present when they argue that WO 01/76371 is silent with respect to "long term effects" because the claimed invention is not directed to any long term effects elicited by the method. The claims are directed to allergen reduction for 14 days and 28 days.

The same method is being performed in WO 01/76371 as that of the instant claims, so the result of allergen reduction for 14 days and 28 days is necessarily inherent. "It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it." *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). See, e.g., *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed.Cir.1999) ("Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.") There is no difference between the claimed method and the method of WO 01/76371. Therefore, the reference teachings anticipate the claimed invention.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 9, 11 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent Application Publication 2 367 243 (Reference 11; IDS filed on 07/26/2006) or WO 01/76371 (Reference 2; IDS filed on 07/26/2006) each in view of WO 03/070286 (Reference 4; IDS filed on 07/26/2006) for the same reasons as set forth in the Office Action mailed on 10/09/2009.

Applicant's arguments filed on 02/08/2010 have been fully considered, but are not persuasive.

Applicant argues:

"The applicant traverses the rejection of the indicated claims in view of the GB243 reference in view of the WO286 reference. The applicant also traverses the rejection of the indicated claims in view of the WO371 reference in view of the WO286 reference.

The rejections are rendered moot in view of the applicant's presently amended claims which cancel prior claims 3 and 12 each of which had not been rejected by the Examiner, and incorporating the limitations of these canceled claims into independent claims 1 and 11, respectively."

Applicant's argument with regard to incorporating the limitations of claims 3 and 12 into claims 1 and 11 is not persuasive. Claims 3 and 12 were not included in the previous rejection because they were already part of the 102(b) rejection over the single references. Rejections under 35 U.S.C. 103 include base claims upon which the rejected dependent claims depend.

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Claims 9 and 18 did not previously depend on claims 3 or 12, so claims 3 and 12 were not included in the rejection.

Therefore, the presently claimed invention still differs from the prior art of GB Patent Application Publication 2 367 243 and WO 01/76371 only in the recitation of "wherein the deactivant comprises β -pinene" of claims 9 and 18. WO 03/070286 discloses a composition that is effective for control of dust mite allergens within a space (In particular, page 5, lines 14-15; page 8, lines 7-9 and lines 20-27, whole document). The composition contains a terpene which may be pinene (In particular, page 9, lines 4-11). It would have been obvious to one of ordinary skill in the art at the time of the invention to use pinene as the terpene of GB Patent Application Publication 2 367 243 or WO 01/76371 since WO 03/070286 teaches that pinene is effective for controlling dust mite allergens. Therefore, the rejection is maintained.

11. Claims 1, 10-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over . GB Patent Application Publication 2 367 243 (Reference 11; IDS filed on 07/26/2006) or WO 01/76371 (Reference 2; IDS filed on 07/26/2006) each in view of U.S. Patent 6,500,445 (Reference 1; IDS filed on 07/26/2006) for the same reasons as set forth in the Office Action mailed on 02/08/2010.

Applicant's arguments filed on 02/08/2010 have been fully considered, but are not persuasive.

Applicant argues:

"The applicant traverses the rejection of the indicated claims in view of the GB243 reference in view of the Pullen reference. The applicant also traverses the rejection of the indicated claims in view of the WO371 reference in view of the Pullen reference.

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The rejections are rendered moot in view of the applicant's presently amended claims which cancel prior claims 3 and 12 each of which had not been rejected by the Examiner, and incorporating the limitations of these canceled claims into independent claims 1 and 11, respectively."

Applicant's argument with regard to incorporating the limitations of claims 3 and 12 into claims 1 and 11 is not persuasive. Claims 3 and 12 were not included in the previous rejection because they were already part of the 102(b) rejection over the single references. Rejections under 35 U.S.C. 103 include base claims upon which the rejected dependent claims depend.

Therefore, the presently claimed invention still differs from the prior art of GB Patent Application Publication 2 367 243 and WO 01/76371 only in the recitation of "wherein the deactivant comprises orange oil or a component thereof" of claims 10 and 19. U.S. Patent 6,500,445 discloses a composition comprising a terpene-containing essential oil such as orange oil for effective, non-toxic control of dust mite allergens within a space (In particular, abstract, column 2, lines 48-62, whole document). It would have been obvious to one of ordinary skill in the art at the time of the invention to use orange oil as the terpene-containing essential oil of GB Patent Application Publication 2 367 243 or WO 01/76371 since U.S. Patent 6,500,445 teaches that terpene-containing essential oils such as orange oil are effective, non-toxic control of dust mite allergens. Therefore, the rejection is maintained.

12. No claim is allowed.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nora M. Rooney whose telephone number is (571) 272-9937. The examiner can normally be reached Monday through Friday from 8:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 22, 2010

Nora M. Rooney

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Patent Examiner

Technology Center 1600

/Nora M Rooney/

Examiner, Art Unit 1644